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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,178	02/25/2004	Renee C. Nesnidal	015163-0310	4705
23524	7590	07/13/2005		
FOLEY & LARDNER 150 EAST GILMAN STREET P.O. BOX 1497 MADISON, WI 53701-1497			EXAMINER ROSENBERGER, FREDERICK F	
			ART UNIT 2878	PAPER NUMBER

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

AK

Office Action Summary

Application No.

10/786,178

Applicant(s)

NESNIDAL ET AL.

Examiner

Frederick F. Rosenberger

Art Unit

2878

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-18, 20-25, 27-29, 31-36, 38, 39 and 41-43 is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☒ Claim(s) 19, 26, 30, 37 and 40 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date 2/25/04.
- 4) ☐ Interview Summary (PTO-413)
 Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Drawings

1. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because elements and labels in the Figures appear to be handwritten.

Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings.

The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Claim Objections

2. Claims 12, 16, 23, and 24 are objected to because of the following informalities:

In claim 12, line 6, the phrase "from the" should be "to the".

In claim 16, line 2, "reflective elements" should be "reflecting elements" to establish proper antecedent basis.

In claim 23, line 1, "the detector" should be "the infrared detector" to establish proper antecedent basis.

In claim 24, line 2, "reflective elements" should be "reflecting elements" to establish proper antecedent basis.

Appropriate correction is required.

3. Claim 19 is objected to for being unclear and indefinite. Claim 19 recites the limitation "an input beam path" in line 41. There is insufficient antecedent basis for this

Art Unit: 2878

limitation in the claim. Specifically, within claim 19, applicant also refers to an “incoming beam path” (lines 2-3) while in parent claim 4, applicant refers to a “beam path from the source to the microscope optics” (line 19). For the purposes of this Office action, input beam path, incoming beam path, and beam path from source to microscope optics have all been interpreted to refer to the same beam path.

4. Claim 40 is objected to for being unclear and indefinite. Claim 40 recites the limitation “an array detector” in line 3. It is unclear whether applicant intends the recitation of “an array detector” to refer to the “infrared detector”, as recited in claim 38, line 9. For the purposes of this Office action, the array detector of claim 40 has been interpreted to refer to and further limit the infrared detector of claim 38.

5. Claims 30 and 37 are objected to under 37 CFR 1.75 as being a substantial duplicate of claim 41. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

6. Claim 26 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 38. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is

Art Unit: 2878

proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Allowable Subject Matter

7. Claims 1-18, 20-25, 27-29, 31-36, 38, 39, and 41-43 are allowed.
8. Claims 12, 16, 23, and 24 would be allowable if amended to correct the minor informalities discussed above.
9. Claims 19, 26, 30, 37, and 40 would be allowable if amended to overcome the objections discussed above.
10. The following is a statement of reasons for the indication of allowable subject matter:

Independent claims 1, 4, 7, 25, 28, 31, 35, 38, and 41 have the feature of using mirrors selectively interposed within a particular beam path in an IR microscope for re-configuring the beam around the microscope aperture. While configurable beam paths using selectively interposable mirrors are known in the art of IR microscopy, the feature of employing interposable mirrors to circumvent or bypass the microscope aperture element en route to the output beam path is novel feature, regardless of if applied to the transmitted beam path or the reflected beam path. Placing interposable mirrors in the input beam path is also known in the art, but in those instances the mirror is either place

Art Unit: 2878

after the aperture (i.e. between the optics and the aperture not between the source and aperture) or is used to circumvent the microscope optics all together. Since the prior art neither teaches nor suggests such features, applicant's disclosure provides a novel and nonobvious improvement over the prior art. Accordingly, the present claims would be allowable.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Messerschmidt (US Patent # 5,225,678) disclose a standard transmittance/reflection IR spectroscopic microscope employing an aperture.

Batchelder et al. (US Patent # 5,689,333) disclose a spectroscopic microscope capable of configuring light beam paths through interposable mirrors.

12. This application is in condition for allowance except for the following formal matters:

- a. Requirement for Formal Drawings (Paragraph 1).
- b. Minor informalities associated with Claims (Paragraph 2).
- c. Objections to Claims (Paragraphs 3-6).

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.


A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frederick F. Rosenberger whose telephone number is 571-272-6107. The examiner can normally be reached on Monday-Friday 7:30 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Porta can be reached on 571-272-2444. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Frederick F. Rosenberger
Patent Examiner
GAU 2878



DAVID PORTA
SUPERVISORY PATENT EXAMINER
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